

REMARKS

Claims 22-27 and 29-69 were pending in the application. By this amendment, claims 35-40, 47-58 and 69 have been canceled.

Claims 22-27 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action states that these claims do not produce a tangible result, citing as support MPEP 2106 IV (B)(1). However, no such Section exists in the MPEP.

Applicant respectfully submits that claims 22-27 produce a tangible result as set out in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998).

In *State Street*, the Court stated at page 1601,

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"--a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

Claim 22 recites the step of "storing the generated color palette in a computer-readable memory for display and selection of individual colors during creation of an image on a computer by a user." Applicant respectfully submits that the step of "storing the generated color palette in a computer-readable memory for display and selection of individual colors during creation of an image on a computer by a user" is analogous to a final share price that is recorded (i.e., stored). The claimed step recites a practical application of a color palette. The display step is analogous to the reporting described in *State Street*, and is relied upon in determining at least the

color that a user will place in a web document (see page 5, lines 12-25 of Applicant's specification). This represents a tangible result.

Applicant respectfully asserts that claims 22-27 recite statutory subject matter, which produces a useful, concrete and tangible result for the reasons outlined above, and request withdrawal of the rejection under 35 U.S.C. § 101.

Claims 35, 47, 69 and those that depend therefrom have been canceled. Therefore, the rejection of these claims is moot.

Claims 32 and 33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However, Applicant only found the language referred to in the rejection in claims 31 and 32. Claims 31 and 32 have been amended to overcome the allegedly indefinite language. Therefore, Applicant submits that claims 32 and 33 refer to groupings having antecedent basis, and withdrawal of the rejection is respectfully requested.

Claims 22-27 and 29-69, of which claims 35-40, 47-58 and 69 have been canceled, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent 6,697,079. Applicant hereby submits a terminal disclaimer to address the Examiner's concerns regarding double patenting regarding claims 22-27, 29-34, 41-46.

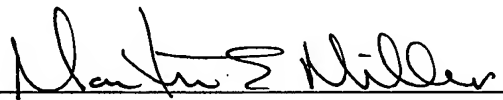
Applicant notes that claims 22-27, 29-34, 41-46 and 59-68 have not been rejected over prior art. Therefore, Applicant respectfully submits that these claims are in condition for allowance, and notification to that effect is respectfully requested.

Should the Examiner have any questions or believes a telephone conference with the undersigned would expedite the prosecution of the present application, he is invited to contact the undersigned.

Respectfully submitted,

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